

REMARKS

The Office Action mailed November 19, 2003, has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance. A Petition for a one-month extension of time and fee therefor are filed herewith.

Claims 1-20, 22, and 24-27 are pending. Claims 21 and 23 have been cancelled without prejudice to the subject matter therein. Claim 1 has been amended. Support for the amendment is found, *inter alia*, in claim 23 as originally filed, and in the specification on page 4, lines 23-26. Claims 28-29 have been added. Support for claim 28 is found, *inter alia*, in the specification on page 5, last paragraph. Support for claim 29, is found, *inter alia*, in claims 1, 25, and 26, as originally filed.

THE SPECIFICATION IS PROPER

The Examiner objects to the specification because no section headings are present. Applicant has amend the specification to include the headings "FIELD OF THE INVENTION," "BACKGROUND OF THE INVENTION," "SUMMARY OF THE INVENTION," "BRIEF DESCRIPTION OF THE DRAWINGS," and "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT" as suggested by the Examiner.

The Examiner also objects to the specification because the first full paragraph on page 2 refers to claim 1, rather than a written description of the invention. The reference to claim 1 has been removed from the paragraph as suggested by the Examiner.

Because Applicant has amended the specification to be in proper format, as suggested by the Examiner, withdrawal of the objection is respectfully requested.

THE CLAIMS ARE NOT INDEFINITE

Claims 1-27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the phrase "wherein ... cushioning" (claim 1, lines 6-8) is ambiguous. The Examiner alleges that "it is not clear whether the predetermined amount of air is trapped during the process of packaging and thus an inherent part of the process or it requires a separate step." Applicant respectfully traverses the rejection.

The present amendment makes clear that the pouches have predetermined dimensions and volume, and that the amount of foodstuff fed into each pouch is less than the volume of each pouch. This combination results in a predetermined amount of air trapped in the pouch to produce a cushioning effect. Therefore, the claims are now definite and withdrawal of the rejection is respectfully requested.

THE CLAIMS ARE NOT ANTICIPATED

Claims 1, 12-13, 16-20, 22-23, and 26-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Davy (U.S. Patent No. 3,199,756). Applicant respectfully traverses the rejection.

To anticipate a claim, the reference must teach every element of the claim. *See* MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The

identical invention must be shown in as complete detail as is contained in the ... claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Davy fails to disclose every element of the claimed invention. In particular, Davy fails to disclose a predetermined amount of air in each pouch to cushion the foodstuff. The Examiner is of the opinion that a pouch containing air is inherent in the disclosure of Davy. However, this is neither intended nor contemplated by Davy.

Davy discloses end-to-end aligned, adjacent bags containing a product therein. The bags are rectangular and flat in formation. When the product occupies the interior of the bag and by reason of its bulk displaces and bulges out the sides of the bag (see column 2, lines 41-42, and lines 50-54). Thus, the bag of Davy does not have a predetermined volume. The bag is initially flat, i.e. without any volume. When the product is placed into the bag, it displaces and fills out the bag. Accordingly, the product is in close contact with and pressed against the sides of the bag, so that it is not cushioned at all. Therefore, even if air is inherently sealed into the bag of Davy, as alleged by the Examiner, it is not enough to produce the cushioning effect of the present invention. Moreover, the volume of Davy's bag is not predetermined. It is dictated by the amount of product inside the bag, i.e. the volume increases with more product and decreases with less product.

On the contrary, the present invention requires that the pouch has predetermined dimensions and volume, and that the bulk volume of the foodstuff is less than the volume of the pouch. Thus, the volume of the present pouch is independent of the amount of foodstuff it contains. These requirements result in a predetermined amount of air included into the pouch when it is sealed. This predetermined amount of air cushions the content of the package against damage, which is not achieved by the disclosure of Davy. This is beneficial in that the pouches can be arranged in a space-filling pattern. In this way, the walls of one pouch are supported by adjacent pouches or by walls of the carton. This means that the pouches are prevented from movement during transport of the carton. That is, each pouch can be held in a fixed position and in a fixed configuration. Accordingly, food-stuff contained within the pouch is not subjected to impacts from the outside. The configuration of the pouches helps to maintain the cushioning effect.

Further, according to MPEP 2112, the “Examiner must provide rationale or evidence tending to show inherency.” To rely on inherency, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” *Ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Moreover, “extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 49

USPQ2d 1949, 1950-1951 (Fed. Cir. 1999) (citations omitted). Here, the Examiner fails to provide any reasoning or objective evidence why the teaching of Davy inherently traps air such that a cushioning effect is produced. The Examiner merely alleges the inherency without providing any reasoning to show that the inherent characteristic necessarily results from the teaching of Davy. The fact that certain result or characteristic may occur or be present is not sufficient to establish inherency. *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); and MPEP 2112. Moreover, applicant has provided objective evidence that the bag of Davy does not contain a predetermined amount of air to produce a cushioning effect of the present invention. Therefore, Day does not anticipate the present invention under 35 U.S.C. § 102. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

THE CLAIMS ARE NOT OBVIOUS

Claims 2-6, 9-11, 14-15, and 24-25 stand rejected under 35 U.S.C. § 103(a) as being obvious over Davy. Claims 7-8 stand rejected under 35 U.S.C. § 103(a) as being obvious over Davy in view of Bonerb (U.S. Patent No. 4,658,989).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143.

The cited references, taken alone or in combination, fail to disclose or suggest every element of the claimed invention. The deficiencies of Davy are discussed above. The Examiner relies on Bonerb to show the formation of pleats in the tube to make the tube expandable. However, because Davy is deficient in disclosing all the elements of claim 1, on which claims 7 and 8 depends, this deficiency is not satisfied by Bonerb.

Moreover, although Bonerb discloses forming pleats in packages, the area of technology is different. In particular, Bonerb discloses a liner, a single liner being inserted into a box. There is no disclosure in Bonerb that a series of connected pouches can be formed which are then assembled and inserted into a box. The pouches of Bonerb cannot be assembled into a strip of sealed pouches. In particular, it is noted that Bonerb requires that both the upper end 14 and the lower end 16 of the container to be openable. This teaching is inapposite to the teaching of Davy. Therefore, one of ordinary skill in the art would not combine the references.

For the reasons noted, Davy and Bonerb, taken alone or in combination, fail to render the present invention obvious within the meaning of 35 U.S.C. § 103. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

As all grounds of rejection have been addressed and overcome, entry of this Amendment as issuance of a Notice of Allowance of the pending claims, as now presented, are respectfully solicited.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage of fees or credit any overpayment thereof to BLANK ROME LLP, Deposit Account No. 23-2185 (000026-00032). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

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